

Application No. 10/649,409  
Reply to Office Action mailed September 21, 2005

### REMARKS

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

By this amendment, claim 32 is canceled without disclaimer or waiver of the subject matter contained therein, and claims 17 and 31 are amended, and new claim 33 is added. Claims 17-31 and 33 are now pending in view of the above amendments.

In the Office Action, claims 17-23, 25, 26, and 31 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent No. 6,862,322 to Ewen, and claims 24, 27, 29-30, and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ewen.

#### Rejection Under 35 U.S.C. § 102(a/b/e)

Applicant traverses the rejection of claims 17-23, 25, 26, and 31 under 35 U.S.C. § 102(e) as being anticipated by Ewen for at least the reason that Ewen fails to disclose or suggest at least "wherein at least one of the at least two gain values is optimized for maximum sensitivity," as recited in claim 17. Ewen discloses a circuit for bandwidth switching, and does not disclose optimization of any values or disclose any means for determining an optimized gain value for maximum sensitivity. Because Ewen fails to disclose or suggest, "wherein at least one of the at least two gain values is optimized for maximum sensitivity," Applicant submits that claim 17 is in condition for allowance.

With respect to claim 31, the claim was amended to include the subject matter of claim 32. As noted in the Office Action, "Ewen fails to specifically teach determining the gain value in accordance with an equation:  $V = K/B$ ." Office Action at 5. Because Ewen fails to disclose

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every claimed element, Applicant submits that claim 31 is in condition for allowance. Claims 18-23, 25, and 26 each depend from an allowable claim and are allowable at least for that dependence. Applicant respectfully requests withdrawal of the rejection based on 35 U.S.C. § 102(e) and allowance of claims 17-23, 25, 26, and 31.

### Rejection Under 35 U.S.C. § 103

Applicant submits that claims 24, 27, 29, and 30 are allowable at least for their dependence on claim 17, and for the reasons previously discussed. Additionally, Applicant traverses the rejection of claims 24, 27, 29, 30 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Ewen for at least the reason that the Office Action failed to establish a *prima facie* case of obviousness.

Applicant notes that it appears that the Examiner is relying on personal knowledge as a basis for rejecting claims 24, 27, 29, and 30. Particularly, the Examiner has simply stated that "both MOS-FET transistor and a bipolar transistor are very well known," with respect to claims 24 and 27, "the claimed packages are standardized and readily available," with respect to claims 29 and 30. The Examiner has not identified any references or other materials as being obvious to combine with the teachings of Ewen. In view of the foregoing, and pursuant to 37 C.F.R. 1.104(d)(2), Applicant hereby respectfully requests an Examiner affidavit that: (i) specifically identifies any and all reference(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claims 24, 27, 29, and 30 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claims 24, 27, 29, and 30.

With respect to the rejection of claim 32, claim 32 has been canceled. However, Applicant submits that the rejection did not establish a *prima facie* case of obviousness at least for the reason that each and every element is not disclosed or suggested by Ewen. As discussed above, the Office Action recognized that "Ewen fails to specifically teach determining the gain value in accordance with an equation:  $V = K/B$ ." Office Action at 5. The Office Action attempted to correct this deficiency by stating that "there being no physical difference between the device of Ewen and that of the claimed invention, it is clear that one skilled in the art could have determined the gain value in accordance with the equation claimed." *Id.* First, Applicant does not agree that there is no physical difference between the device of Ewen and the presently

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claimed invention. Second, "[b]road conclusory statements standing alone are not 'evidence.'" *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). Since *Ewen* fails to disclose the equation, *Ewen* cannot suggest the use of the equation to one of skill in the art as required to establish a *prima facie* case of obviousness. The Examiner has not identified any references or other materials as being obvious to combine with the teachings of *Ewen*.

Because no *prima facie* case of obviousness has been established, Applicant submits that claims 24, 27, 29, 30 and 32 are in condition for allowance. Applicant requests the withdrawal of the rejection based on 35 U.S.C. § 103(a).

### New Claim 33

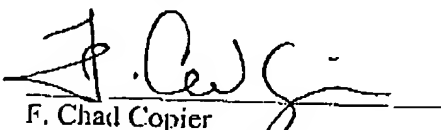
New claim 33 is added by this amendment, support for the new claim can be found in claims 17 and 29. No new matter has been added. Applicant submits that claim 33 is allowable at least for the reasons similar to those discussed above.

### CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims. The Examiner is encouraged to contact the undersigned if the Examiner believes that a telephone interview or Examiner's amendment will further the prosecution of this application.

Respectfully submitted,  
WORKMAN NYDEGGER

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